

Notice of Allowability

Application No.

10/773,941

Applicant(s)

FU ET AL.

Examiner

Art Unit

Timothy C. Vanoy

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed on June 1, 2006.
2. ☒ The allowed claim(s) is/are 1, 5-9, 13-15, 19-23, 26 and 27.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date Apr. 16, 2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other _____

Timothy C. Vanoy
Timothy C. Vanoy
Primary Examiner
Tech Center 1700

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: While U. S. Patent 5,786,294 describes a similar process for making zirconia catalysts with the aid of a stabilizing agent such as sulfuric acid, tungsten oxide, molybdenum oxide, etc. (please see col. 5 Ins.18-22 in U. S. Patent 5,786,294), and also while US 2004/0007531 A1 describes a somewhat similar process for making hydrous zirconium oxide with the aid of what appears to be a stabilizing agent such as phosphate ion (please see paragraph no. 0015 and also paragraph no. 0036, for example, in US 2004/0007531 A1), the references can not be combined together to form a 35USC103 rejection over the applicants' claims. The stabilizing agents used in the process of U. S. Patent 5,786,294 are used to delay crystallization of the mesoporous walls and/or delay transformation from a tetragonal to a monoclinic modification at calcinations temperatures (please see col. 3 Ins. 55-60 in U. S. Patent 5,786,294). There is no indication in US 2004/0007531 A1 that the phosphate "stabilizing agent" mentioned in paragraph no. 0036 would achieve these same purposes of delaying crystallization of the mesoporous walls and/or delaying transformation from a tetragonal to a monoclinic modification at calcinations temperatures that is set forth in col. 3 Ins. 55-60 in U. S. Patent 5,786,294. Therefore, any proposed substitution of the phosphate "stabilizing agent" of US 2004/0007531 A1 in lieu of the "stabilizing agents" of U. S. Patent 5,786,294 into the process and composition of U. S. Patent 5,786,294 in an attempt to render obvious the applicants' claims under 35USC103 would "render inoperative" the invention of U. S. Patent 5,786,294. If the primary reference is rendered unsatisfactory

Art Unit: 1754

for its intended purpose by the teachings of a secondary reference, then there can be no suggestion or motivation to make the proposed modification: please see the discussion of the *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) court decision set forth in section 2143.01(V) in the MPEP 8th Ed Rev. 3, Aug. 2005.

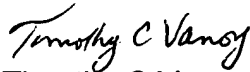
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance.".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 571-272-8158. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Timothy C Vanoy
Primary Examiner
Art Unit 1754

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